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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/625,042	07/22/2003	Remo Anton Hochstrasser	21272 US	1081
151 7590 12/21/2007 HOFFMANN-LA ROCHE INC. PATENT LAW DEPARTMENT 340 KINGSLAND STREET NUTLEY, NJ 07110			EXAMINER SIEFKE, SAMUEL P	
			ART UNIT 1797	PAPER NUMBER
			MAIL DATE 12/21/2007	DELIVERY MODE PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

## Office Action Summary

**Application No.**

10/625,042

**Applicant(s)**

HOCHSTRASSER ET AL.

**Examiner**

Samuel P. Siefke

**Art Unit**

1797

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 01 October 2007.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-8 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-8 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## DETAILED ACTION

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to

consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 1-8 are rejected under 35 U.S.C. 102(e) as being anticipated by WO 01/50121 (herein after WO '121) in view of Moi et al. (USPN 5,938,906).

WO '121 discloses a method for removing a gelatinous material that comprises the steps of separating a gel cutting from the gel (page 2, lines 29-31), placing the cut gel in a new container (page 3, lines 28-32, page 5, lines 7-9) and covering the gel cutting with an equilibrating fluid (processing solution, page 10, lines 11-20). WO '121 states the processing fluid is pre-filled within the multi-well processing plate 32 and the gel fragment is placed therein. It appears the gel perimeter of the gel cutting is approximately equal to the perimeter of the new container (fig. 3e). The Examiner is interpreting that when the gel is placed with in the processing plate containing the processing fluid, the gel is covered with the processing fluid after the gel is placed therein because the gel would sink or the user would submerge the cut gel so the processing fluid would cover the entire surface area of the cut gel. Regarding the cut gell having an edge that contours to the receiving processing fluid, it is the Examiner's interpretation that the cutting tip has a negative bevel which allows for easier excision of the spots, bands, or plaques from the gel 34. As seen in figure 3a-3e, the gel 34 is cut and a portion is removed and placed in the processing well 32. The gel conforms the inside of the processing well because it is smaller and has parallel sides that has the same contours of the well. Therefore the gel can be moved around within the processing well because there is a space between the gel and the sidewall of the

processing well. WO '121 further states that different sizes of cutting can be cut out of the gel depending on the size of the spots, bands or plaques (page 10, line 33- page 11, line 9). If a larger spot were to be excised, the larger cutting would inherently consume the entire space in the processing well 32 and would thereby be immovably disposed therein.

WO '121 does not teach a gel cutting containing a plurality of concentration points of different substances, holding the gel in the processing well by clamping means or covering the gel with an equilibrating fluid before cutting.

Regarding the newly amended claims having the limitation of the gel cutting containing a plurality of concentration points of different substances. It is well known in the art that gel slabs are employed to perform analysis on a plurality of different samples on the same slab. It would have been obvious to one having an ordinary skill in the art at the time of the invention to modify WO '121 to employ cutting of the gel slab to include a plurality of samples therein on the cutting to a container for further sampling because it would allow for screening multiple different samples with one test substance. This screening is routinely employed for testing diverse samples against one test drug. Moi teaches a casting cassette for gel electrophoresis that comprises clamps for holding the gel within the container (fig. 5a-5d). It would have been obvious to one having an ordinary skill in the art at the time of the invention to modify WO '121 to employ a clamp to hold the cut gel in the processing well to prevent the gel cutting from moving around in the container and preventing unwanted movement therein. Regarding claim 7, it would have been obvious to one of ordinary skill in the art to modify WO '121 to cover

the pre-cut gel with a processing fluid to prepare the gel for cutting. This is well known in the art of electrophoresis.

### ***Response to Arguments***

Applicant's arguments filed 10/1/07 have been fully considered but they are not persuasive. Applicant argues, "Its is not clear that the processing solution referred to in the WO 01/50121 reference is equivalent to the equilibrating liquid of the present application." The Examiner maintains that the processing solution is the equilibrating liquid of the present applicaiton because it performs the same function, i.e. process the sample by providing a chemical reaction. The instant claims do not recite what the Applicant is arguing on page 10 of the remarks section, "in the present invention the equilibrating liquid perfoms a functional task of surrounding the get cutting to ensure a constant degree of swelling to provide a gel having a same dimensions." The broadest interpretation of the claim by the Examiner is that the gel cutting is covered by a liquid that performs something to the gel cutting. The reference teaches a processing solution that performs a process on the cutting while the gel is immersed therein.

In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., the gel cutting to lie in the equilibrating liquid for a sufficient length of time) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Samuel P. Siefke whose telephone number is 571-272-1262. The examiner can normally be reached on M-F 7:00am-5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jill A. Warden can be reached on 571-272-1700. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Sam P. Siefke

  
December 20, 2007